

REMARKS

These remarks are in response to the Office Action mailed September 18, 2008. Claims 28, 29 and 43 have been canceled without prejudice to Applicants' right to prosecute the canceled subject matter in any divisional, continuation, continuation-in-part or other application. Claim 27 has been amended. Support for the amendments can be found throughout the specification as filed (see, e.g., pages 16-19 and previously pending claims 28, 29, and 43). No new matter is believed to have been introduced.

Applicants acknowledge the Examiner indication that claims 28, 29 and 43 are allowable if re-written in independent format.

I. REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claims 27, 30-42 and 44-45 stand rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the enablement requirement. The claims allegedly contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants respectfully traverse this rejection.

The Office alleges that the specification does not provides a nucleic acid sequence other than the sequence of SEQ ID NO:1 and SEQ ID NO:2. However, the Examiner is respectfully reminded that the claimed invention should be considered with reference to the knowledge of one of ordinary skill in the art. Furthermore, the specification need not teach and preferably omits what is known in the art to avoid burdening the Office with treatises of recognized methods and techniques in the art.

The disclosure provides methods of making, compositions and methods of use of antibodies (including single chain antibodies) capable of inhibiting cell growth such as growth associated with cancer cells. Having isolated and sequenced antibody domains from antibodies that bind to ErbB2 receptor, the disclosure puts into the hands of the public the identified polypeptides having the sequences (including conservative substitutions) and function of the claimed invention. For example, based upon the "high level" of skill in the art minor modifications can be made to the disclosed inventions without departing from Applicants' claimed

invention. Thus, Applicants' invention puts in the hands of a person of ordinary skill in the art modified antibodies based upon the sequence provided by the disclosure according to techniques described in the specification (see, e.g., pages 13 and 14).

Furthermore, as the Examiner indicates that specification is enabled for IK17 Fab's and scFvs. For at least the foregoing reasons, Applicants respectfully request withdrawal of this rejection.

II. REJECTION UNDER 35 U.S.C. §102(e)

Claims 27, 31 and 34-35 stand rejected under §102(e) as allegedly anticipated by Witztum et al. U.S. Patent No. 6,225,070. Applicants respectfully traverse this rejection.

Applicants submit that the '070 patent does not teach or suggest and IK17 antibody or fragment thereof. Thus, the reference does not disclose each and every element of Applicants' claimed invention. Accordingly, the rejection may be withdrawn.

III. REJECTION UNDER 35 U.S.C. §103

Claims 30-34, 36-42 and 44-45 stands rejected under 35 U.S.C. §103 as allegedly unpatentably over Witztum et al. U.S. Patent No. 6,225,070 (as the primary reference. Applicants respectfully traverse this rejection.

U.S. Patent 6,225,070 is only available as a reference under 35 U.S.C. §102(e). Furthermore, the present application was subject to assignment, at the time the invention was made, to the same entity as the '070 patent. Pursuant to 35 U.S.C. §103(c)(1), the '070 patent is not available as prior art under 35 U.S.C. §103. Thus, Applicants respectfully request withdrawal of the rejections under this section.

For, at least, the foregoing reasons the claims submitted herewith are non-obvious over the references either alone or in combination.

Applicant submits that the claimed invention is patentable and request reconsideration and notice of such allowable subject matter.

The Director is authorized to charge any required fee or credit any overpayment to Deposit Account Number 50-4586, please reference the attorney docket number above.

The Examiner is invited to contact the undersigned at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,

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